



**UNITED STATES DEPARTMENT OF COMMERCE**  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/128,622	08/04/98	PRINCE	R APV-30200

QM12/1122  
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EXAMINER

NGUYEN, K

ART UNIT

PAPER NUMBER

3712

DATE MAILED:

11/22/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/128,622

Applicant(s)  
Robert P. Prince

Examiner  
Kien T. Nguyen

Group Art Unit  
3712



☒ Responsive to communication(s) filed on Sep 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) 9, 16-19, 23-27, and 29-32 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-8, 10-15, 20-22, and 28 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 and 5

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### ***Claim Rejections - 35 USC § 112***

1. Claims 3-8, 10-15, 20, 22, 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 22 are very confusing because they failed to further limit the structural components of their respective independent claims. They merely recite the functions of the putter without further reciting any structural features or components to support such function. For example, it was not clear how the putter "...designed, dimensioned, sized and weighted sufficient for enabling said golfer to putt said golf ball by causing said lower hand grip ....only at said point". A method of putting a golf ball is a human behavior. Different golfers have different ways, habits and/or techniques of using the putter, and there is no standard method of putting the golf ball either. For example, two golfers may have completely two different styles of putting but both golfers are capable of putting the ball in the hole.

Claims 4-8 and 10-15 are indefinite because they are directly or indirectly depended upon claim 3.

Claim 20 is indefinite because its scope has not been clearly defined. For example, claim 1 is an apparatus claim and claim 20 which depends upon claim 1 is a method claim.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-8, 10-15, 20, 21, 22, and 28, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Garber U.S. Patent 4,592,552.

Garber disclosed a golf putter comprising a shaft (54) having first and second ends; a head (12) fixed to the first end; a handle fixed to the second end, the handle including an upper hand grip (62), a lower hand grip (64); Figs. 2A-2C show the angle between the shaft and the head is less than about 90 degrees and more than about 45 degrees. It is noted that Garber failed to disclose the weight of the putter head as set forth in claims 1, 5, 6, 21. However, a conventional weight for a golf putter head is about 320 grams (see Hannon U.S. Patent 5,632,691), and it is very well known in the art to add more weight on any golf head by various known methods such as lead tapes, adjustable weight inserts for decades to accommodate different golfers. Therefore, it would have been a matter of design choice to add more weights to accommodate any particular golfer.

In re claims 4, 7, 10, 13, such materials for the putter head, handle, and shaft are conventional materials as stated in the specification of the present application. Therefore, it would have been a matter of design choice to make the putter of Garber with any known materials as stated in the present application.


In re claims 8, 11, 12, 14, 15, the specific dimensions of the shaft and grip of the putter are also within the conventional dimension (see Hannon U.S. Patent 5,632,691).

In re claims 20 and 28, column 4 of Garber disclosed such method of using a putter.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Garber in view of Huang U.S. Patent 5,671,923.

It is noted that Garber failed to teach a counterweight positioned in the handle as set forth in claim 2. However, as stated on page 3 of the specification of the present application, Huang teaches a method of providing a counterweight in the handle to provide a more balance golf club. Therefore, it would have been obvious to one of ordinary skill in the art to modify the putter of Garber with the teaching of Huang for the reason as set forth above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kien Nguyen whose telephone number is (703) 308-2493.

  
Kien T. Nguyen  
Primary Examiner

ktn

November 21, 1999